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BEFORE THE BOARD OF PATENT APPEALS

AND INTERFERENCES

Paper No. 14

Application Number: 09/176,012

Filing Date: October 20, 1998

Appellant(s): Jorg Metternich et al.

Scott W. Reid

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 24, 2002.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

The following ground(s) of rejection are applicable to the appealed claims:

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7)Grouping of Claims

The rejection of claims 1-10, 12-25 and 27-29 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claims 1-10, 12-25 and 27-29 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claims stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8)Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9)Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

5,875,405	HONDA	2-1999
6,112,078	SORMUNEN ET AL	08-2000

(10)Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for

the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

2.   Claims 15, 16 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Honda, U.S. Patent

No. 5,875,405.

Regarding claim 15, Honda discloses:

a) using a user data processing system (e.g. MT1) to prepare a query profile, having an associated

brief command at least one information requirement, where the brief command can be produced using the

keypad of a mobile telephone (col. 4, lines 12-30);

b) sending the query profile in accordance with step a) using the user data processing system to an

information supplier (col. 4, lines 27-30); and

c) storing the query profile at the information provider on an information supplier data-processing

system which can communicate with the telephone network of the mobile telephone (col. 4, lines 2-8 ; figure

1).

Regarding claim 16, Honda discloses the method in accordance with Claim 15 characterized in that

step b) is effected over a data link (RF) between the user data-processing system and the information

supplier data-processing system (figures 1 and 6).

Regarding claim 20, Honda discloses the method in accordance with Claim 16 characterized in that

the data link is effected through a modem to the information supplier data processing system (figure 1).

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections

set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of
> this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter
> as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which
> said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 1, 2, 6, 7, 9-12, 14, 21, 23-27 and 29 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Honda, U.S. Patent No. 5,875,405 and Sormunen et al (Sormunen), U.S. Patent

No. 6,112,078.

Regarding claim 1, Honda discloses:

a) using a user data processing system (e.g. MT1) to prepare at least one query profile, where each

query profile has at least one information requirement and an associated brief command, where each brief

command can be specified using the keypad of a mobile telephone (col. 4, lines 12-30);

b) sending the query profile using the user data-processing system to an information supplier (e.g.

base station) (col. 4, lines 27-30);

c) sending on information call using a mobile telephone (e.g. MT2) to the information supplier

inherently containing at least one of the brief commands as evidenced by the fact that the base station knows

what info MT2 wants (col. 1, lines 55-62 and col. 5, lines 15-36);

d) inherently comparing the brief command sent in accordance with step c) with the brief commands

of the query profiles prepared and sent in accordance with steps a and b) as evidenced by the fact that an

acknowledgment from the base station was received at the mobile and the base station transfers the

requested information to the mobile (col. 5, lines 19-30);

e) putting together the information of the information requirements contained in the associated query

profile in the event of agreement in accordance with step d) (col. 5, lines 40-49); and

f) sending the collected information to the mobile telephone (col. 5, lines 50-58);

Honda, however, fails to specifically disclose the information being presented to a user of the mobile

telephone by way of the mobile telephone.

Sormunen discloses a method in which requested information is displayed (visual) to the mobile

telephone (col. 4, lines 33-39).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify

Honda with the teachings of Sormunen for the purpose of allowing the user to see the requested information.

Regarding claim 2, the combination of Honda and Sormunen discloses the method in accordance

with Claim 1 characterized in that step b) takes place via a data link (RF) between the user data processing

system and an information supplier data processing system (figures 1 and 6).

Regarding claim 6, the combination of Honda and Sormunen discloses the method in accordance

with Claim 2 characterized in that the data link is effected through a modem to the information supplier

data-processing system (figure 1)

Regarding claims 7 and 21, the combination of Honda and Sormunen discloses the method in

accordance with Claims 2 and 16 and further discloses wherein the data link is affected through the Internet

to the information supplier data processing system (Sormunen, col. 4, lines 4-11).

Regarding claim 23, Honda discloses:

a) sending a call for information by means of a mobile telephone to an information provider

containing at least a brief command (col. 5, lines 15-27);

b) inherently comparing the sent brief command with the brief command of the query profile as

evidenced by the fact that an acknowledgment from the base station was received at the mobile and the base

station transfers the requested information to the mobile (col. 5, lines 19-30);

c) putting together the desired information of the at least one information requirement of the query

profile in the event of agreement in accordance with step b) (col. 5, lines 40-49);

d) sending the collected information to the mobile telephone (col. 5, lines 50-58).

Honda, however, fails to specifically disclose the information being presented to a user of the mobile

telephone via the mobile telephone.

Sormunen discloses a method in which requested information is displayed (visual) to the mobile

telephone (col. 4, lines 33-39).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify

Honda with the teachings of Sormunen for the purpose of allowing the user to see the requested information.

Regarding claims 9 and 24, the combination of Honda and Sormunen discloses the method in

accordance with Claims 1 and 23 , and further discloses wherein step c) and step a) are effected through the

SMS of the mobile telephone (Sormunen, col. 3, lines 54-62).

Regarding claim 10, the combination of Honda and Sormunen discloses the method in accordance

with Claim 1 characterized in that steps d) through f) are inherently each effected through one of the

information suppliers programs as evidenced by the fact the actions are taking place within the information

supplier (base station) (Honda, col. 5, lines 19-55).

Regarding claims 11 and 26, Honda discloses the method of claims 1 and 23 as described above, and

inherently a program effected through the information supplier as evidenced by the fact the actions are

taking place within the information supplier (base station) (Honda, col. 5, lines 19-55). The combination,

however, fails to specifically disclose how many programs are being utilized for the steps d), e), f), b), c) and

d).

However, the examiner contends that the number of programs used for implementing the transfer of

information is a design preference, and that it would have been obvious to use more than one program based

on the desired outcome of the system performance.

Regarding claim 12, the combination of Honda and Sormunen discloses the method in accordance

with Claim 1, and further discloses wherein the sending, in accordance with step f), is effected via another

mobile telephone mobile telephone (Honda, col. 5, lines 50-58).

Regarding claims 14 and 29, the combination of Honda and Sormunen discloses the method in

accordance with Claims 1 and 23 , and further discloses wherein the information, in accordance with steps

g) and e), are supplied visually (Sormunen, col. 4, lines 33-39).

Regarding claim 25, the combination of Honda and Sormunen discloses the method in accordance

with Claim 23, and further discloses that steps b) through d) are inherently effected through a program of the

information provider as evidenced by the fact the actions are taking place within the information supplier

(base station) (Honda, col. 5, lines 19-55).

Regarding claim 27, the combination of Honda and Sormunen discloses the method in accordance

with Claim 23, and further discloses that the transmission in accordance with step d) is effected via a mobile

telephone (Honda, col. 5, lines 50-58).

5.   Claims 3-5, 8, 13, 22 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Honda,

U.S. Patent No. 5,875,405, Sormunen et al (Sormunen), U.S. Patent No. 6,112,078 and well known prior art.

Regarding claim 3, the combination of Honda and Sormunen discloses the method in accordance

with Claim 1 as described above. The combination, however, fails to specifically disclose wherein the query

profile is produced by a speech computer.

The examiner, however, takes official notice that it is very well known in the art that information can

be produced by means of a speech computer.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify

the combination of Honda and Sormunen with the teachings of well known prior art for the purpose of

having the capability to provide information during times when a user of the mobile phone can't use their

hands to submit information.

Regarding claim 4, the combination of Honda and Sormunen discloses the method in accordance

with Claim 1 as described above. The combination, however, fails to specifically disclose wherein the

information call is sent with a PIN, where the PIN establishes entitlement to call up the specified

information.

However, the examiner takes official notice that it is well known in the art for a PIN to be

transmitted along with requested information from a user.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify

the combination of Honda and Sormunen with the teachings of well known prior art for the purpose of

verifying the user requesting the information for security purposes.

Regarding claim 5, the combination of Honda and Sormunen discloses the method in accordance

with Claim 1, as described above. The combination, however, fails to specifically disclose wherein the

information call is sent with a telephone number of the caller, where the telephone number establishes

entitlement to call for the information.

However, the examiner takes official notice that it is well known in the art for the telephone number

to be transmitted along with requested information from a user.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify

Honda and Sormunen with the teachings of well known prior art for the purpose of verifying the user

requesting the information for security purposes.

Regarding claims 8, the combination of Honda and Sormunen discloses the method in accordance

with Claim 1 as described above. The combination, however, fails to specifically disclose downloading

JAVA applets stored on the server of the information supplier through the Internet to the data processing

system of the user of the mobile telephone; and preparing the query profile in accordance with step a) by

means of the JAVA applets.

Sormunen discloses a method of downloading information from an information supplier to the data processing system of a user of the mobile telephone by way of the Internet (col. 2, lines 32-49, col. 4, lines 4-11).

The combination of Honda and Sormunen also fails to disclose JAVA as the programming language used for the Internet communication. However, the examiner takes official notice that it is well known in the art that JAVA is a widely used programming language for the Internet.

Therefore, at the time of invention, it would have been obvious to a person of ordinary skill in the art to modify the combination of Honda and Sormunen with the teachings of well known prior art as it would have been a design preference in choosing the programming language used for the Internet communication based on system and need performance.

Regarding claims 13 and 28, the combination of Honda and Sormunen discloses the method in accordance with Claims 1 and 23 as described above and further discloses information being transferred on a data link between the mobile and the information provider (Honda, figure 1). The combination, however, fails to specifically disclose wherein the information is sent to a user of the mobile telephone via a network operator.

The examiner however, takes official notice that it is well known in the art to incorporate network operators as suppliers of information to a mobile user.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify the combination of Honda and Sormunen with the teachings of well known prior art as it would have been a design preference to incorporate a network operator in the system based on the desired system performance.

Regarding claim 22, Honda discloses the method in accordance with claim 15 as described above.

Honda, however, fails to specifically disclose downloading JAVA applets stored on a server of the

information supplier through an Internet to the data processing system of the user of the mobile telephone;

and preparing the query profile in accordance with step a) by means of the JAVA applets.

Sormunen discloses a method of downloading information from an information supplier to the data

processing system of a user of the mobile telephone by way of the Internet (col. 2, lines 32-49, col. 4, lines

4-11).

Although Sormunen fails to disclose JAVA as the programming language used for the Internet

communication, the examiner, however, takes official notice that it is well known in the art that JAVA is a

widely used programming language for the Internet.

Therefore, at the time of invention, it would have been obvious to a person of ordinary skill in the art

to combine Honda with the teachings of Sormunen and well known prior art for the purpose of having

access to the world wide web (WWW), and further it would have been an design preference in choosing the

programming language used for the Internet communication based on system and need performance.

6.   Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Honda, U.S. Patent

No. 5,875,405.

Regarding claim 17, Honda discloses the method in accordance with claim 15 as described above.

Honda, however, fails to specifically disclose wherein the query profile is produced via a speech computer.

The examiner, however, takes official notice that it is very well known in the art that information can

be produced by means of a speech computer.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify

Honda with the teachings of well known prior art for the purpose of having the capability to provide

information during times when a user of the mobile phone can't use their hands to submit information.

Regarding claim 18, Honda discloses the method in accordance with claim 15 as described above.

Honda, however, fails to specifically disclose wherein the call for information is sent with a PIN where the

PIN establishes entitlement to call for the specified information.

However, the examiner takes official notice that it is well known in the art for a PIN to be

transmitted along with requested information from a user.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify

Honda with the teachings of well known prior art for the purpose of verifying the user requesting the

information for security purposes.

Regarding claim 19, Honda discloses the method in accordance with claim 15 as described above.

Honda, however, fails to specifically disclose wherein the call for information is sent with the telephone

number of the caller, where the telephone number establishes entitlement to call for the information.

However, the examiner takes official notice that it is well known in the art for the telephone number

to be transmitted along with requested information from a user.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify

Honda with the teachings of well known prior art for the purpose of verifying the user requesting the

information for security purposes.

(11)Response to Argument

With respect to independent claim 15, Appellant argues on pages 11 and 12 of the brief, that Honda

fails to disclose preparing a query profile containing at least one information requirement and having an

associated brief command, wherein the information requirement is different form the information itself.

Appellant states that the claims imply that this information exists independently of the query, wherein this

information could be stock information, or account balance information from a banking system as disclosed

in the specification. Appellant further argues that Honda fails to disclose a user data processing system used

to prepare the query profile and send this profile to the information supplier, wherein the user data

processing system is a separate and distinct entity from the user's mobile phone as further disclosed in the

specification.

Appellant states that Honda actually discloses a mobile station which prepares abbreviated dialing

commands and associated phone numbers which are stored in an ADR table, wherein the abbreviated dialing

command is later entered and sent for the retrieval of the associated phone number.

In response to applicant's argument that the references fail to show certain features of applicant's

invention, it is noted that the features upon which applicant relies (i.e., the information requirement being

different from the information itself, and the mobile station being a separate entity from a user processing

system) are not recited in the rejected claim(s). Although the claims are interpreted in light of the

specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d

1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Therefore, based on the scope of the claims, Honda does read on the limitations claimed.

Specifically, the abbreviated dialing commands and the associated phone numbers in Honda which are

prepared by the user of the mobile phone is synonymous with the claimed query profile, since the claim
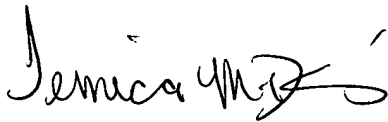
language only requires the preparation of a query profile having an information requirement (i.e. the phone

number) and an associated brief command (i.e. the abbreviated dialing command).

With respect to independent claims 1 and 23, since appellant argues on pages 15 and 16 of the brief

that these claims discuss identical elements as claim 15, the same reasoning of the rejection based on Honda
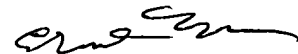
is the same.

It is hereby requested that the rejections be sustained.

Respectfully submitted,

Conferees:

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August 7, 2002

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